

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: NAKAJIMA=7

In re Application of:)	Conf. No.: 3687
)	
Hiroshi NAKAJIMA et al)	Art Unit: 1617
)	
Appln. No.: 10/571,199)	Examiner: David D. Webster
)	
I.A. Filed: July 29, 2005)	Washington, D.C.
371(c): March 9, 2006)	
)	
For: BENZYLISOQUINOLINE)	June 19, 2009
DERIVATIVE- OR ...)	

REPLY TO ELECTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are in receipt of the Office Action mailed May 19, 2009, entirely in the nature of a requirement for election of species. Applicants reply below.

First, however, applicants respectfully request the PTO to acknowledge receipt of applicants' papers filed under §119.

The examiner holds that the claims are directed to two(2) patentably distinct species, and requires that applicants elect only one of the two. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Neferine from among the compounds of formula I, and O-Methylarmepavine from the compounds of formula II, with

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traverse and without prejudice. All the claims read on the elected species, claims 43, 44, 46 and 47 being generic, and claim 45 being specific to Neferine.

As regards patentable distinctness, applicants take no position on that issue at the present time, but do agree that the species may indeed be patentably distinct from one another. However, that is not the issue. As the examiner correctly notes, the present application is the U.S. National Stage of a PCT application wherein the unity of invention PCT Rules 13.1 and 13.2 apply. The fact that generic claims exist and have not been validly rejected, and for which there is no apparent basis for their rejection, means that the generic claims themselves inherently link the species so as to form a single general inventive concept under PCT Rules 13.1 and 13.2.

Applicants respectfully note that all the claims must in any event be examined because they all cover the elected subject matter. Applicants respectfully submit that there is no reason for maintaining the requirement which is not in accordance with the PCT Rules as noted above.

Respectfully submitted,

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